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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,261	07/23/2003	Shobha Murari	JPS 032454.00062	8413

7590 05/05/2005

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EXAMINER

FEELY, MICHAEL J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/625,261

Applicant(s)

Murai et al.

Examiner

Michael J. Feely

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13, 14, 16, 23, 26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23, 26 and 27 is/are rejected.
- 7) ☒ Claim(s) 13, 14 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 0703.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Claims 13, 14, 16, 23, 26, and 27 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 23 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by LeBlanc et al. (US Pat. No. 3,597,301).

Regarding claims 23 and 27, LeBlanc et al. disclose: **(23)** in a method of making an epoxy resin article (Abstract; column 3, lines 2-21) reinforced by multifilament, fiberglass fabric (Abstract; column 2, line 68 through column 3, line 2), the improvement which comprises providing a latent catalyst inhibitor on the surfaces of the filaments of the fiberglass fabric (Abstract; column 2, lines 34-52); and **(26)** an epoxy resin article made by the method of claim 23 (Abstract); and having a substantially reduced number of voids in the space between filaments in the multi-filament fiberglass fabric (*inherent due to the use of boric acid treatment – see Abstract*).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over LeBlanc et al. (US Pat. No. 3,597,301) in view of Kabeta et al. (US Pat. No. 5,075,459).

Regarding claim 27, LeBlanc et al. disclose the article of claim 26; however, they do not explicitly disclose (27) a printed wiring board made from said article.

Kabeta et al. disclose a similar article (*Abstract; column 6, lines 10-53*). The teachings of Kabeta et al. demonstrate that epoxy prepregs are recognized in the art as suitable materials for forming printed wiring boards – *see column 6, lines 15-18*.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the article of LeBlanc et al. to form a printed wiring board because the teachings of Kabeta et al. demonstrate that epoxy prepregs are recognized in the art as suitable materials for forming printed wiring boards.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 23 and 26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 6,720,080.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 5 of the issued patent are fully encompassed by claims 23 and 26 of the instant invention.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the method of instant claim 23 and make the article of instant claim 26 because patented claims 1 and 5 are fully encompassed by the instant claims.

8. Claim 27 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 6,720,080 in view of Kabeta et al. (US Pat. No. 5,075,459).

Regarding claim 27, the issued patent claims disclose the article of claim 26; however, they do not explicitly disclose (27) a printed wiring board made from said article.

Kabeta et al. disclose a similar article (*Abstract; column 6, lines 10-53*). The teachings of Kabeta et al. demonstrate that epoxy preregs are recognized in the art as suitable materials for forming printed wiring boards – *see column 6, lines 15-18*.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the article of the issued patent to form a printed wiring board because the teachings of Kabeta et al. demonstrate that epoxy preregs are recognized in the art as suitable materials for forming printed wiring boards.

Allowable Subject Matter

9. Claims 13, 14, and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 13, the closest prior art is LeBlanc et al.; however, they fail to teach or suggest the additional pretreatment step of immersing the fabric in a bath containing at least one cationic amino-silane coupling agent, prior to treating the fabric with the finish bath containing a weak acid (the inhibitor). Kabeta et al. disclose a process of treating a glass fabric with a cationic amino silane; however, there is no motivation to combine the teachings of these two references. Claims 16 and 14 are allowable because they are dependent from claim 13.

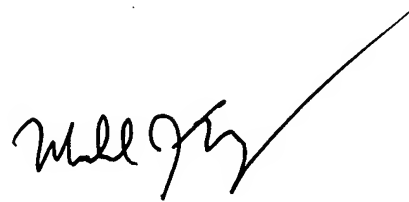
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Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Feely whose telephone number is 571-272-1086. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Michael J. Feely', with a long, sweeping diagonal line extending upwards and to the right from the end of the signature.

Michael J. Feely
Primary Examiner
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May 2, 2005